

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed December 14, 2004. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 101

Claims 19-26 have been rejected under 35 U.S.C. § 101 for purportedly being directed to non-statutory subject matter. Specifically, the Office Action states that the claims “fail to recite the use of any type of technology (e.g., computer system) within the recited steps.”

As a first matter, Applicant submits that the claims do in fact recite the use of a technology: the recited personal medical database *device* is one such technology. For at least this reason, claims 19-26 are believed to be directed to statutory subject matter.

Although claim 19 is believed to claim statutory subject matter in its original form, Applicant has amended claim 19 to recite “permitting the practitioner to review at least a portion of the medical information stored in the personal medical database device by downloading the medical information from the personal medical database device to a *computer system*”.

In view of the above, Applicant submits that claims 19-26 claim statutory subject matter. Applicant therefore respectfully requests that the rejection be withdrawn.

II. Claim Rejections - 35 U.S.C. § 112

A. First Paragraph Rejections

Claims 1-26 have been rejected under 35 U.S.C. § 112, first paragraph, for purportedly failing to comply with the enablement requirement. In particular, the Office Action states that Applicant's specification "fails to explain how the memory device is manufacture in order to obtain the claimed storage density."

In response to the rejection, Applicant notes that Applicant's specification, both explicitly and via incorporation by reference, provides great detail as to how to make and use memory devices, such as ARS and MRAM devices, that have high storage capacities. Furthermore, Applicant explicitly stated example storage densities in Applicant's specification, including the claimed "200 kb/mm³" that is the subject of the rejection. Given these two facts, Applicant submits that a person having ordinary skill in the art could, with reference to Applicant's specification and through reasonable experimentation, attain the aforementioned storage density.

Applicant further notes that no question has been raised as to whether such storage densities are feasible (at least not explicitly). Indeed, one of the art references used to reject Applicant's claims states: "Last week, Hewlett-Packard unveiled its work on atomic resolution storage (ARS), a technology that allows 10 gigabytes of data to be stored on a tiny compact flash card" and "How much data can you store on a compact flash card, a tiny package little bigger than the size of a quarter? Until recently, my answer ended in megabytes. But now I'm off by several orders of magnitude." (See the Toronto Star article entitled "Storage capacity set to take quantum leap.")

As a final point, Applicant asserts that the enablement requirement does not require that Applicant provide a step-by-step description of how to make the invention. As described by the Court of Appeal for the Federal Circuit:

“A patent must contain a description that enables one skilled in the art to make and use the claimed invention . . . ‘An inventor need not, however, explain every detail since he is speaking to those skilled in the art.’ *In re Howarth*, 654 F.2d 103, 105, 210 USPQ 689, 691 (CCPA 1981). ‘Not every last detail is to be described, else patent specifications would turn into production specifications, which they were never intended to be.’ *In re Gay*, 309 F.2d 769, 774, 50 CCPA 725, 733, 135 USPQ 311, 316 (CCPA 1962).”

[*DeGeorge v. Bernier*, 768 F.2d 1318, 226 USPQ 758 (Fed. Cir. 1985)]

In view of the foregoing, Applicant submits that claims 1-26 are properly enabled. Applicant therefore respectfully requests that the rejection of these claims under 35 U.S.C. § 112, first paragraph, be withdrawn.

B. Second Paragraph Rejections

Claims 2, 3, 11, 12, 20, and 21 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

In response to the rejection, Applicant has amended the claims to add definitions for the acronyms “ARS” and “MRAM”. In view of those amendments, it is respectfully asserted that claims 2, 3, 11, 12, 20, and 21 define the invention in the manner required by 35 U.S.C. § 112. Accordingly, Applicant respectfully requests that the rejections to these claims be withdrawn.

III. Claim Rejections - 35 U.S.C. § 102(e)

Claims 19, 22, and 26 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Reeves (U.S. Pat. No. 6,747,561). Applicant respectfully traverses this rejection.

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the Reeves reference. Applicant discusses Applicant’s claims and the Reeves reference in the following.

Applicant’s independent claim 19 provides as follows (emphasis added):

19. A method, comprising:

carrying a personal medical database device comprising at least one memory device having a storage density of at least 200 kB/mm³, the device holding personal medical information of a user and not comprising a battery;

presenting the personal medical database device to a medical/dental practitioner prior to receiving medical/dental services;

permitting the practitioner to review at least a portion of the medical information stored in the personal medical database device by downloading the medical information from the personal medical database device to a computer system; and

receiving medical/dental services from the practitioner.

Applicant notes that Reeves does not teach at least “carrying a personal medical database device comprising at least one memory device having a storage density of at least 200 kB/mm³, the device holding personal medical information of a user and not comprising a battery”, as is recited in claim 19. As to the storage density limitation, that limitation is believed to be adequately enabled by Applicant’s original specification and therefore comprises an explicit limitation that must be considered.

As to the “carrying” limitation, Applicant notes that Reeves’ device comprises a battery in every embodiment. In contradistinction, Applicant’s claim 19 explicitly recites carrying a device that “does not comprise a battery”. Notably, a battery is required by Reeves’ device to perform various core functions of the device. Therefore, producing Reeves’ device without a battery would render various components of Reeves’ device inoperable. Applicant further notes that ample support for the “does not comprise a battery” limitation is found in Applicant’s specification and drawings, which neither describe nor show a battery. A person having ordinary skill in the art would further appreciate that, given that Applicant’s device only comprises non-volatile memory devices, no such battery is necessary.

Due to the shortcomings of the Reeves reference described in the foregoing, Applicant respectfully asserts that Reeves does not anticipate Applicant’s claims. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

IV. Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims 1, 2, 4-7, 10, 11, 15-18, and 20

Claims 1, 2, 4-7, 10, 11, 15-18, and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Reeves in view of Gibson, et al. (“Gibson,” U.S. Pat. No. 5,557,596). Applicant respectfully traverses this rejection.

As is identified above in reference to independent claim 19, Reeves does not teach a personal medical storage device having a memory device comprising a storage density of at least 200 kB/mm³ and comprising no battery, which are limitations that also appear in independent claims 1 and 10. In that Gibson does not provide a teaching that can overcome the deficiencies of the Reeves reference, Applicant respectfully submits that claims 1, 2, 4-7, 10, 11, 15-18, and 20 are allowable over Reeves/Gibson for at least the same reasons that claim 19 is allowable over Reeves.

B. Rejection of Claims 3 and 12

Claims 3 and 12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Reeves in view of Gibson and an article by Stephen Shankland (“Shankland”). Applicant respectfully traverses this rejection.

As a first matter, Reeves and Gibson do not teach a personal medical storage device having a memory device comprising a storage density of at least 200 kB/mm³ and comprising no battery, which are limitations that also appear in independent claims 1 and 10. In that Shankland does not provide a teaching that can overcome the deficiencies of the Reeves and Gibson references, Applicant respectfully submits that claims 3 and 12 are allowable over Reeves/Gibson/Shankland for at least the same reasons that claims 1 and 10 are allowable over Reeves/Gibson.

As a second matter, Applicant objects to the application of the Shankland article against Applicant's claims. Specifically, the Shankland article can only be relied upon for what it actually teaches. What it does not teach, however, is any detail about the technology that Applicant has described and is claiming. In other words, the Shankland article is not an enabling disclosure that can be considered a "teaching" of ARS technology. To the contrary, the article at best comprises a casual reference to "ARS". As such, the article cannot properly be relied upon as comprising a prior art "teaching" of the claimed technology.

C. Rejection of Claim 21

Claim 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Reeves in view of Shankland. Applicant respectfully traverses this rejection.

As is identified above in reference to independent claim 19, Reeves does not teach a personal medical storage device having a memory device comprising a storage density of at least 200 kB/mm³ and comprising no battery. In that Shankland does not provide a teaching that can overcome the deficiencies of the Reeves reference, Applicant respectfully submits that claim 21 is allowable over Reeves/Shankland for at least the same reasons that claim 19 is allowable over Reeves.

Applicant incorporates the comments regarding usage of the Shankland reference provided above in relation to claims 3 and 12.

D. Rejection of Claims 13 and 14

Claims 13 and 14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Reeves in view of Gibson and alleged admissions of prior art.

As is identified above in relation to claim 10, Reeves and Gibson do not teach a personal medical storage device having a memory device comprising a storage density of at least 200 kB/mm³ and comprising no battery. Applicant therefore respectfully submits that claims 13 and 14 are allowable for at least the same reasons that claim 10 is allowable over Reeves/Gibson.

As a further matter, Applicant objects to the allegation that Applicant admitted that transferring medical information into a standardized database template is known. For support of the allegation, the Examiner cites page 17, lines 2-16 which provide (emphasis added):

As will be appreciated by persons having ordinary skill in the art, transfer of the collected information into electronic form can be achieved through several different known methods. For instance, this information can be manually entered into an appropriate software program stored in the computing device memory 904. By way of example, such a program could comprise standardized templates having fields for certain medical information. Although such data entry could be time-consuming, especially where a large amount of information is to be input, it provides the advantage of standardizing the format of the information to permit easier access of information on the part of the practitioner and/or practitioner's staff. Alternatively or in addition, digital images of medical records can be scanned into electronic form with an appropriate scanning device (not shown). In any case, a copy of the information can be stored (at least temporarily) within the memory 904 of the computing device 900. If maintained, this electronic copy of the information provides the user with an additional database of information that can be relied upon should his or her database device 100 become lost or damaged.

As is evident from the above excerpt, *nowhere* does Applicant make an admission of prior art. Instead, Applicant merely states that persons having ordinary skill in the art will “appreciate,” i.e., understand, the description that follows. Such a statement does not equate to an admission of prior art.

Although it is not improper for an Examiner to apply admitted prior art in making prior art rejections under 35 U.S.C. §103(a), it is equally clear that, to do so, the Applicant *must* make an admission. Stated otherwise, it is not proper to apply information disclosed by an applicant without an admission by that applicant that the disclosed information is in fact prior art. This fact is clear from MPEP § 2129 which provides (emphasis added):

When applicant states that something is prior art, it is taken as being available as prior art against the claims. Admitted prior art can be used in obviousness rejections. *In re Nomiya*, 509 F.2d 566, 184 USPQ 607, 610 (CCPA 1975) (Figures in the application labeled “prior art” held to be an admission that what was pictured was prior art relative to applicant's invention.).

From the above excerpt, it is clear that disclosed material can only be taken as admitted prior art when the applicant *actually states* that it is prior art. For instance, in the example provided in MPEP § 2129, figures labeled “prior art” may be used as admitted prior art.

In view of the foregoing, it is clear that no admission has been made by Applicant and therefore, as per MPEP 2129, Applicant's disclosure may not be used as admitted prior art. Applicant therefore respectfully submits that the rejection is improper as for failing to disclose or render obvious one or more explicit limitations of

Applicant's claims. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

E. Rejection of Claims 23-25

Claims 23-25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Reeves as applied to claim 19, and further in view of Examiner's use of official notice. Applicant respectfully traverses this rejection.

As is identified above in reference to independent claim 19, Reeves does not teach a personal medical storage device having a memory device comprising a storage density of at least 200 kB/mm³ and comprising no battery. Applicant respectfully submits that claims 23-25 are allowable over Reeves/Gibson for at least the same reasons that claim 19 is allowable over Reeves.

As a further matter, Applicant objects to the Examiner's use of official notice. Applicant submits that the concept of permitting a certain level of access to patient medical records "wherein the level of access attained by the practitioner depends upon the password/passcode entered by the practitioner" is not generally known.

As is described in MPEP § 2144.03, official notice is only acceptable if the subject of the official notice is "capable of such instant and unquestionable demonstration as to defy dispute." Applicant asserts that the above-described limitation is not capable of "instant and unquestionable demonstration." Applicant thereby traverses that finding official notice. In accordance with MPEP § 2144.03(C), the Examiner must provide documentary evidence in the next Office Action if the rejection is to be maintained.

F. Rejection of Claims 8-9

Claims 8-9 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Reeves and Gibson as applied to claim 1, and further in view of a Toronto Star article entitled “Storage capacity set to make quantum leap” (“Toronto Star article”). Applicant respectfully traverses this rejection.

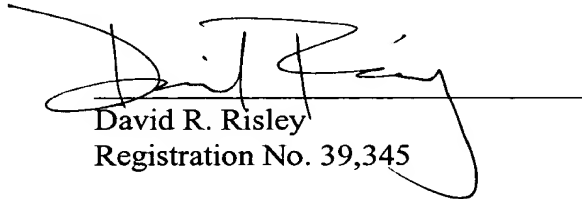
As a first matter, Reeves and Gibson do not teach a personal medical storage device having a memory device comprising a storage density of at least 200 kB/mm³ and comprising no battery, which are limitations that also appear in independent claim 1. In that the Toronto Star article does not provide a teaching that can overcome the deficiencies of the Reeves reference, Applicant respectfully submits that claims 8-9 are allowable over Reeves/Gibson/Toronto Star article for at least the same reasons that claim 1 is allowable over Reeves/Gibson.

As a second matter, Applicant objects to the application of the Toronto Star article against Applicant’s claims. Specifically, the Toronto Star article can only be relied upon for what it actually teaches. The article teaches nothing about the technology that Applicant has described and is claiming. In other words, the Toronto Star article is not an enabling disclosure that can be considered a “teaching” of MRAM technology.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

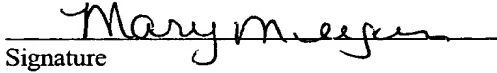
Respectfully submitted,



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